REMARKS

Applicant is in receipt of the Office Action mailed January 16, 2004. Claims 1, 4-9, 12-20, 22-34, 37-42, and 45-46 remain pending in the case. Further consideration of the present case is respectfully requested in light of the following remarks.

Section 103 Rejections

Claims 20 and 22-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brandle et al. (U.S. 5,146,593, "Brandle") in view of Admitted Prior Art (APA). Applicant respectfully disagrees.

Applicant provided arguments in the previous Response showing that the APA teaches away from Applicant's invention as represented in claim 20. More specifically, Applicant noted that the relevant portion of the specification (the Background section) describes one prior art approach which involves "creating a DLL that has entry points that call a graphical program indirectly by interfacing with an Active X out-of-process server, where this Active X server is operable to invoke the desired graphical program." This prior art approach is an indirect way for "enabling graphical programs to be called using shared libraries." Applicant further noted that this prior art approach suffers from a number of drawbacks, particularly relating to efficiency and the requirement that the user create an Active X out-of-process server specifically for this purpose. Applicant also noted that since the present invention as represented in claim 20 includes novel features or limitations that address, at least in part, these drawbacks, the APA *teaches away* from Applicant's invention as represented in claim 20, and that the APA is thus not properly combinable with Brandle.

The Office Action stated that Applicant's arguments with respect to claims 1, 4-9, 12-20, 22-34, 37-42, and 45-46 were considered but are moot in view of the new ground(s) of rejection. However, the Office Action did not apply the new grounds of rejection to claims 20 and 22-29, and so Applicant submits that claims 20 and 22-29 are patentably distinct over the APA and Brandle for at least the reasons provided above. Applicant has provided further arguments for the patentability of claims 20 and 22-29 below.

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As the Examiner is certainly aware, to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

As held by the U.S. Court of Appeals for the Federal Circuit in Ecolochem Inc. v. Southern California Edison Co., an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. Moreover, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular . . .. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Additionally, per *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

Similarly, per *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998), the invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art. See, e.g., Uniroyal, Inc. v. Rudkin Wiley Corp., 837 F.2d 1044, 1051 52, 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); Interconnect

Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination).

Applicant notes that neither Bandle nor the APA provides a motivation to combine, and submits that combining Bandle with the APA is thus improper. Applicant also respectfully submits that the Examiner has used hindsight analysis to assemble Applicant's system from *selected* portions of the referenced art, using Applicant's invention as claimed as a "blueprint".

For example, Applicant notes that the APA includes a DLL that has entry points that call a graphical program indirectly by interfacing with an Active X out-of-process server which is operable to invoke the desired graphical program. The Examiner has apparently selected only those features of the APA that are represented in claim 20, and combined them with portions of Bandle in an attempt to construct Applicant's invention. Applicant thus submits that the combination is improper.

Applicant respectfully submits that, for at least the reasons provided above, the section 103 rejection of claims 20 and 22-29 is improper, and that these claims are patentably distinguishable over Brandle and the APA, either singly or in combination, and are thus allowable. Removal of the section 103 rejection of claims 20 and 22-29 is respectfully requested.

The Office Action rejected claims 16-18 and 30-32 under 35 U.S.C. 103(a) as being unpatentable over APA (Admitted Prior Art) in view of Wadhwa et al. (U.S. 6,389,588 B2), and further in view of Hullot (U.S. 5,163,130, "Hullot"). Applicant respectfully disagrees.

Applicant submits that neither the APA, Wadhwa, nor Hullot provides a motivation to combine. Additionally, as argued above, the APA teaches away from Applicant's invention as claimed, and so the combination of APA, Wadhwa, and Hullot is improper.

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Applicant further submits that even if the references were combinable, which Applicant argues they are not, the resulting combination does not produce Applicant's invention as represented in claims 16 and 30. For example, as also described above, any combination that includes the APA includes an Active X out-of-process server, whereby the graphical program is invoked indirectly. This feature is not found in claim 16 or claim 30.

Additionally, as noted in the previous Response, the Wadhwa reference discusses generally building a new program into an executable program or dynamic linked library (DLL), but as the previous Office Action admitted, "Wadhwa does not explicitly teach a graphical program, specifying a functional interface for the graphical program, and the shared library includes a function created according to the functional interface." The Office Action attempted to combine Wadhwa with the APA to provide these features, but, as argued above, combining with the APA is improper, and does not produce Applicant's invention as represented in claims 16 and 30.

Regarding Hullot, Applicant submits that the Examiner has improperly equated the graphical user interface of Hullot with the functional interface of claims 16 and 30. For example, as described in the present Application on page 15, line 23 – page 16, line 9:

> "If a graphical program runs as a standalone program, the graphical program may receive the values for its inputs via the corresponding user interface controls on the user interface panel and may display the output values in the corresponding user interface indicators.
>
> However, if a graphical program is called through a shared library, the input values may be specified by parameters that the calling program passes to the shared library entry point function for the graphical program. Similarly, the output values for the graphical program may be written to output parameters that are passed by the calling program. In step 202, the user may define a functional interface specifying the desired mapping of the graphical program inputs/outputs to entry point function parameters. The user interface of Figure 4B illustrates a button labeled "Define VI Prototype..." that enables a user to define a functional interface for each graphical program to be exported to the shared library. Step 202 may involve the user interactively specifying a functional interface, as described below. Alternatively, the graphical programming system may automatically create the functional interface based on the inputs and outputs of the graphical program.

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The functional interface may be constructed or formatted in any way appropriate for a particular type of shared library. For example, for a DLL, a C-style functional interface may be specified." (emphasis added)

Applicant submits that Hullet does not disclose a functional interface as disclosed in the present application, but rather, discloses a graphical user interface, and so Hullet teaches away from Applicant's invention as represented in claims 16 and 30.

For at least the reasons provided above, Applicant respectfully submits that claims 16 and 30 are patentably distinct over APA, Wadhwa, and Hullot, either singly or in combination. Thus, Applicant submits that claims 16 and 30, and those claims respectively dependent thereon, are allowable. Removal of the section 103 rejection of claims 16-18 and 30-32 is respectfully requested.

Claims 1, 4-9, 12-15, 19, 33-34, 37-42, and 45-46 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hullot, in view of APA and Wadhwa, and further in view of Bandle. Applicant respectfully disagrees.

Applicant submits that none of the cited references provides a motivation to combine. Additionally, as argued above, both the APA and Hullot teach away from Applicant's invention as claimed, and so the combination of Hullot, APA, Wadhwa, and Bandle is improper. As also argued above, even in combination, the cited references do not teach Applicant's invention as claimed. For example, as described above, any combination that includes the APA includes an Active X out-of-process server, whereby the graphical program is invoked indirectly, which teaches away from Applicant's invention as represented in claim 1. As also mentioned above, Hullet does not disclose a functional interface as disclosed in the present application, but rather, discloses a graphical user interface. Thus, even in combination (which Applicant argues is improper), the cited references fail to teach all of the features of claim 1.

Thus, for at least these reasons, Applicant submits that claim 1 is patentably distinct and unobvious over Hullot, APA, Wadhwa, and Bandle, either singly or in combination, and so claim 1, and those claims dependent thereon, are allowable. Claim 34 includes similar limitations as claim 1, and so the argument presented above apply

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with equal force to claim 34. Applicant thus respectfully submits that claim 34 and those claims dependent thereon are similarly allowable.

Claim 19 depends from claim 16, which has been shown to be allowable, and so claim 19 is also allowable for at least the reasons provided above.

Claim 33 depends from claim 30, which has been shown to be allowable, and so claim 33 is also allowable for at least the reasons provided above.

Claims 37-42 and 45-46 depend from claim 34, which has been shown to be allowable, and so claim s 37-42 and 45-46 are also allowable for at least the reasons provided above.

Removal of the section 103 rejection of claims 1, 4-9, 12-15, 19, 33-34, 37-42, and 45-46 is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.
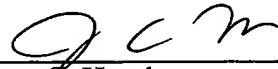
CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-39900/JCH.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard
☒ Notice of Change of Address

Respectfully submitted,

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